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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,386	12/28/1999	MARIO GUILLEN	BAL6019P0090	9922

32116 7590 08/26/2003

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 08/26/2003

30

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/473,386

Applicant(s)

GUILLEN, MARIO

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

The declaration and the request for reconsideration have been entered June 16, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### ***Enablement***

Claims 13-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Enablement is considered in view of the *Wand* factors (MPEP 2164.03).

*State of the prior art.* At the time the invention was made there were not many published literature regarding the crossing of *Impatiens flaccida* and *I. hawkeri*. Arisumi (1980) has shown that no germination occurred with the crossing of *I. flaccida alba* and *I. herzogii* (see page 630, column 2 and Table 1). Arisumi (1985) later reported that no viable seedlings were obtained from the crossing of the Indian group and the New Guinea -Indonesian group on page 276.

*Working examples.* It appears in the specification that there is only one example of breeding *Impatiens flaccida* with *I. hawkeri*.

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*Predictability of the art.* In the Trees declaration (paper number 29, page 2), Mr. Trees state that he had actually seen 100 impatiens plants with a trailing habit from the crossing of *Impatiens flaccida* with *I. hawkeri*, but apparently all of the plants were the result of a single cross (hybridization event). In the specification, the examples describe the trailing habit of two hybrids created by this method. It is uncertain if one skilled in the art would be able to repeat this same process because the crossing of two species will not always have the same outcome as described in this instant application. For example, Strefeler indicates that the mite resistance in New Guinea impatiens is due to P.I. 354259 in its pedigree on page 233. It was deduce that the dominant resistant gene in P.I. 354259 caused the pest resistance. If this is so, then possibly the trailing habit is also due to a single plant and therefore the process disclosed in the specification may not be repeatable. Strefeler states on page 233 that "great diversity observed in progeny of crosses for flower and foliage color, size, and shape" with regard to New Guinea impatiens breeding. Strefeler acknowledge a "high degree of genetic diversity" among the impatiens germplasm because of its geographic location on page 243. In addition, to the unpredictability of the interspecific breeding Fehr states, "A population derived from crosses between many divergent parents is expected to express more genetic variance than a population derived from a view related parents." (See page 96). Therefore, the progenies produced from the breeding method of *I. flaccida* and *I. hawkeri* would be unpredictable due to the genetic diversity in New Guinea impatiens.

With regard to claims 19-23, which are drawn to the pedigrees of 2245B with a trailing habit, it would be unpredictable that the offspring will also have the trailing habit. It is unknown whether the trailing habit is due to a dominant or recessive gene, or even a combination of genes. For same reason stated above one skilled in the art would not have predicted that the

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trailing habit would necessarily be passed on to the offsprings because of the high genetic diversity in *impatiens* plant.

*Amount of experimentation necessary.* Due to the unknown result of method of breeding as claimed, it would require a considerable amount of experimentation to acquire the trailing habit.

For reasons discussed above, it would require undue experimentation for one skilled in the art to use the claimed methods other than what is intended to be deposited.

### ***Written Description***

Claims 13-24 and 26-30 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for reason stated on paper number 27, pages 2-4.

### ***Response to Arguments***

Applicant's arguments filed on June 16, 2003 (pages 1-3) have been fully considered but they are not persuasive.

Applicant argues that the examiner has the initial burden of presenting evidence why a person skilled in the art would not recognize the claimed invention, 2245B. This argument is not persuasive because the applicant has not disclosed in the specification all the phenotypic characteristics of the progenies from the crossing of *Impatiens flaccida* with *I. hawkeri*. A person skilled in the art would not be able to recognize the other characteristic possibilities such as, the non-trailing *Impatiens* plant as shown in Figure 1 (paper number 29). Figures 2

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and 3 show two different *impatiens* plants with the trailing habit, which were not described in the specification. The only plants cited in the specification are 2245B and 2257B.

Applicant continues to argue with the support of the Trees declaration that a skilled artisan would be able to distinguish a trailing habit *impatiens* plant as claimed in this application. This argument is not persuasive because, although Mr. Trees state that he had actually saw 100 *impatiens* plants from the crossing of *Impatiens flaccida* and *I. hawkeri*, these 100 plants apparently resulted from a single cross. Therefore, one cannot predict whether this result would be reproducible, for the reason discussed in the rejection above.

Thus, it is unclear that the Applicant could predict the progenies with a trailing habit because of the many phenotypic characteristics that may occur for reason stated in the enablement rejection above. As a result, one skilled in the art would not recognize any plant made with a trailing habit as claimed, given the disclosure in the specification.

Applicant is warned that the amendment should not introduce new matter in the disclosure of the invention.

### **Conclusion**

No claims are allowed.

Applicant stated on paper number 25, page 2 that he will provide the deposit information at time of allowance. Applicant is reminded that the deposit information of regenerable tissues of 2245B should be disclosed in the specification and the accession number should be set forth in the claims.

### **Future Correspondence**

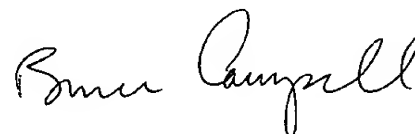
Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Friday from 6:30 a.m. to 5:00 p.m. and off on Fridays.

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If attempts to reach the Examiner by tel phone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax numbers for the group are Before Final (703) 872-9306, After Final (703) 872-9307, and Customer Service (703) 872-9305.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service Center whose telephone number is (703) 308-0198.

JH

A handwritten signature in black ink, appearing to read "Bruce Campell", with a stylized, cursive script.

**BRUCE R. CAMPELL, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**